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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH A. WALKER, JR.
and ALEXANDER K. SCHOWTKA

Appeal 2008-6328
Application 10/713,446
Technology Center 2600

Decided:[1] March 20, 2009

Before KENNETH W. HAIRSTON, JOHN A. JEFFERY,
and BRADLEY W. BAUMEISTER, *Administrative Patent Judges.*

BAUMEISTER, *Administrative Patent Judge.*

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from the Examiner's rejection of claims 1, 3-7, 11, 13-17 and 21-34. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm.

A. *Appellants' invention*

Appellants' invention relates to a method and system for facilitating user customization of the image content of an image container in an electronic product design. More specifically, the method and system display particular image information to a user in response to the user's request to perform custom cropping for a selected image container in an electronic product design displayed to the user. (App. Br. 2).

B. *The claims*

Claims 1and 21 are representative.[2] They read as follows:

1. A computer-implemented method for facilitating user customization of the image content of an image container in an electronic product design, the method comprising

displaying an electronic product design to a user, the design containing at least one or more user-customizable image containers, each image container having content that is at least a portion of a base image associated with the image container;

[2] Appellants effectively argue claims 1, 3-7, 11, 13-17, 22-25, and 27-34 together as a first group, and separately argue claims 21 and 26 together as a second group. *See* App. Br. 3-9; Reply Br. 1-3. Accordingly, we select claims 1 and 21 as respectively representative of the first and second groups.

allowing the user to select an image container in the electronic product design for customization of the content of the image container, and

in response to a user request to perform custom cropping for the selected image container, displaying to the user

the associated base image, and

a cropping indicator positioned to indicate to the user the portion of the base image that is the current content of the image container.

21. The method of claim 1 wherein the base image associated with the selected image container was not associated with the selected image container by the user.

C. The references and rejections

The Examiner relies on the following prior art references to show unpatentability:

Noda	US 2002/0030634 A1	Mar. 14, 2002
Roses	US 2003/0055871 A1	Mar. 20, 2003
Haeberli	US 6,587,596 B1	July 1, 2003

1. Claims 1, 3-7, 11, 13-17, and 21-34 stand rejected under 35 U.S.C. § 103(a) as obvious over Roses in view of Noda and Haeberli.

Rather than repeat the arguments of the Appellants or the Examiner, we refer to the Brief and the Answer for their respective details.[3] In this decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

PRINCIPLES OF LAW

1. Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

I. Claims 1, 3-7, 11, 13-17, 22-25 and 27-34.

ISSUE

The Examiner asserts that (1) Roses is directed towards a method for facilitating user customization of the image content of an image container in an electronic product design (Ans. 3); (2) Roses discloses most of the elements claimed, including the provision of a user-initiated cropping

[3] We refer to (1) the Appeal Brief filed Mar. 13, 2007; (2) the Examiner's Answer mailed July 18, 2007; and (3) the Reply Brief filed Sept. 18, 2007 throughout this opinion.

function, but fails to disclose that in response to a user request to perform cropping for the selected image container, the following two elements will be displayed: the associated base image and a cropping indicator positioned to indicate to the user the portion of the base image that is the current content of the image container (Ans. 3-5); (3) Noda teaches the display of the base image and the cropping indicator (Ans. 6); and (4) Haeberli and Noda each teach custom cropping with a cropping indicator positioned to indicate the portion of the base image that is the current content of the image container (Ans. 6, 19).

Appellants acknowledge that the cited prior art teaches an image container, a base image, and a cropping indicator (FF 1), but argue that "Noda and Haeberli disclose base images and disclose cropping indicators positioned in a *default* location on the base image" (Reply Br. 2, emphasis in original). Appellants assert that the prior art does not collectively teach or suggest providing a user with a direct visual indication of the portion of a base image that is currently the image content of a selected image container (Reply Br. 2).

The issue before us, then, is whether Appellants have shown that the Examiner erred in finding that the cited prior art collectively teaches or suggests providing a user with a visual indication of the portion of a base image that is currently the image content of a selected image container.

FINDINGS OF FACT

The record supports the following Findings of Fact (FF) by a preponderance of the evidence:

1. Appellants acknowledge that the cited prior art teaches an image container, a base image, and a cropping indicator (Reply Br. 1).

2. Appellants acknowledge that (1) "Haeberli discloses a system allowing a user to process uploaded photographs and incorporate the processed photographs into a product design containing one or more images;" (2) "Haeberli…provides a user interface and user-selectable tools to allow the user to control various attributes of the images, such as image [cropping];" and (3) Figs. 9a and 9b [of Haeberli] depict a cropping indicator (904) that can be positioned by the user over a base image (906) to identify a desired area for cropping" (App. Br. 6).

3. Appellants do not dispute whether any of the disclosed teachings of Noda, and Haeberli are combinable with Roses' document generation and printing system.

4. Appellants' Specification does not provide any express definition for the term "current" in relation to the claim language, "the current content of the image container."

5. Appellants' Specification does not provide any express definition for what acts may constitute "a user request" in relation to the claim language, "in response to a user request to perform custom cropping for the selected image container."

6. Haeberli discloses "[u]ser interface 900 includes a crop display 902 for indicating which parts of the image are *currently included in a selected portion* 904 and a cropped portion 906 of the image" (Haeberli, col. 13, ll. 46-48; emphasis added).

7. Haeberli's cropping functions include (1) crop-shape radio buttons 912 and (2) various crop controls: "Zoom In" 916; "Zoom Out" 918; and "Move" 920 (Haeberli, col. 13, l. 26 – col. 14, l. 56; figs. 9a and 9b).

8. Clicking on the crop-shape or crop-control button will select both which image attribute to change and the new value for the selected image attribute (Haeberli, col. 14, ll. 16-21).

9. Haeberli provides an example wherein "if the user clicks on the left 'Move' button 920, the selected portion 904 [of figure 9a] is moved to the left and a new foreground image [sic: 904] is generated and displayed [as shown in figure 9b]" (Haeberli, col. 14, ll. 21-24).

10. In response to a user clicking on either the crop-shape button or one of the crop control buttons, Haeberli's system will display to the user the associated image and a cropping indicator positioned to indicate to the use the portion of the base image that is the current content of the image container (fig 9b).

ANALYSIS

Appellants acknowledge that (1) "Haeberli discloses a system allowing a user to process uploaded photographs and incorporate the processed photographs into a product design containing one or more images;" (2) "Haeberli…provides a user interface and user-selectable tools to allow the user to control various attributes of the images, such as image [cropping];" and (3) Figs. 9a and 9b [of Haeberli] depict a cropping indicator (904) that can be positioned by the user over a base image (906) to identify a desired area for cropping" (FF 2). Appellants do not dispute whether any of

the disclosed teachings of Noda, and Haeberli are combinable with Roses' document generation and printing system (FF 3). Rather, Appellants argue that Haeberli's cropping indicator is "positioned in a *default* location on the base image" (Reply Br. 2, emphasis in original), but Haeberli does not teach:

> responding to a user request to perform custom cropping of an image container by displaying the associated base image and displaying a cropping indicator positioned over the base image in a location that indicates to the user the portion of the base image that is the current content of the image container, as discussed in the last full paragraph on page 4 of the Appeal Brief.

(*Id.*).

The cited paragraph of the Appeal Brief's page 4 is, in turn, a description of the invention *as disclosed in Appellants' Specification*. Both the Appeal Brief's cited paragraph, and also the portions of the Specification to which the Appeal Brief in turn cite, describe modifying the content of the "current image" of the image container (App. Br. 4; Spec, ¶ 0026). The referenced "current image" is described in the Specification as one that was pre-cropped prior to the user selecting the "Change cropping of this image" radio button 402 of window 400 (Spec, ¶¶ 0026, 0027; fig. 4). While not expressly stated, this portion of the Specification seemingly implies that the portion of the base image constituting the "current image" was pre-selected by the image template provider prior to the user ever accessing the cropping tool. Accordingly, we understand Appellants' position to be that none of the prior art references teach responding to a user request to perform custom cropping of an image container by displaying the associated base image and displaying a cropping indicator positioned over the base image in a location that indicates to the user the portion of the base image *that was pre-selected*

prior to the user accessing any cropping tool. This argument is not persuasive.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). In the present case, Appellants' Specification does not provide any express definition for the term "current" in relation to the claim language, "the *current* content of the image container" (FF 4). Moreover, Appellants' Specification does not provide any express definition for what acts may constitute "a user request" in relation to the claim language, "in response to *a user request* to perform custom cropping for the selected image container" (FF 5).

Haeberli discloses "[u]ser interface 900 includes a crop display 902 for indicating which parts of the image are *currently included in a selected portion* 904 and a cropped portion 906 of the image" (FF 6). Haeberli also discusses further details of the available cropping functions (*see e.g.,* Haeberli, col. 13, l. 26 – col. 14, l. 56; figs. 9a and 9b). These available cropping functions include crop-shape radio buttons 912 and various crop controls: "Zoom In" 916; "Zoom Out" 918; and "Move 920" (FF 7). Clicking on the crop-shape or crop-control buttons selects both which image attribute to change and the new value for the selected image attribute (FF 8). Haeberli provides an example wherein "if the user clicks on the left 'Move' button 920, the selected portion 904 [of figure 9a] is moved to the left and a new foreground image [sic: 904] is generated and displayed [as shown in figure 9b]" (FF 9).

A user's action of clicking on either the crop-shape button or one of the crop control buttons fully meets the language "a user request to perform custom cropping for the selected image container." In response to such actions being performed, Haeberli's system will display to the user the associated image and a cropping indicator positioned to indicate to the use the portion of the base image that is the current content of the image container (FF 10). Restated, the user's actions at this stage of Haeberli's cropping function—when combined with Roses and Noda—fully meet all of the requirements of the steps of claim 1.

Accordingly, we need not decide whether other actions at any earlier or later stages of Haeberli's process also render claim 1 obvious. That is, we need not decide whether Haeberli's "default" content, displayed prior to a user initially selecting any cropping functions, constitutes "current" content (*See* Reply Br. 2). Likewise, we need not decide whether Haeberli's "*saved* cropping information might be employed to respond to a custom cropping request from a user to display a cropping indicator positioned to indicate to the user the portion of the base image that is the current content of the image container" (App. Br. 7; emphasis added).

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's obviousness rejection of representative claim 1. Accordingly, we will sustain the Examiner's rejection of that claim and claims 3-7, 11, 13-17, 22-25 and 27-34 which fall with claim 1.

II. Claims 21 and 26

ISSUE

The Examiner has taken the position that (1) the claim term, "base image" reads on any of the images that are stored in Roses' image basket database 214; and (2) the claim term, "image container," reads on Roses' document template (Ans. 3-5). The Examiner then interprets Roses as not expressly teaching the base image being associated with the selected image container by an entity other than the user (Ans. 11). But the Examiner asserts that under the broadest reasonable definition of the term, "associated," the claim limitation reads on the image association being performed by a computer, albeit at the user's prompting (Ans. 19-21). The Examiner further asserts that this sort of automated association is taught by Noda (Ans. 11, 19-21).

Appellants have not disputed whether (1) the claim term, "base image" reads on any of the images that are stored in Roses' image basket database 214; or whether (2) the claim term, "image container," reads on Roses' document template (FF 11). Rather, Appellants argue that the portions of Noda cited by the Examiner indicate that all images are placed in image containers under user control, not automatically (Reply Br. 2-3).

The issue before us, then, is whether Appellants have shown that the Examiner erred in finding that the cited prior art collectively teaches or suggests someone other than the user associating a base image with the selected image container.

FINDINGS OF FACT

The record supports the following Findings of Fact (FF) by a preponderance of the evidence:

11. Appellants have not disputed whether (1) the claim term, "base image" reads on any of the images that are stored in Roses' image basket database 214; or whether (2) the claim term, "image container," reads on Roses' document template.

12. The word, "associate," is defined variously as: (1) "to connect or bring into relation;" (2) "to join as a companion, partner or ally;" and (3) "to unite; combine" (Dictionary.com, *available at* http://dictionary.reference.com/browse/associate).

13. The word, "select" is defined as: (1) "to choose in preference to another or others; pick out" (Dictionary.com, *available at* http://dictionary.reference.com/browse/select).

14. Roses discloses a document composition application that allows a user to create a document having selected images incorporated therein (Roses, Abstract).

15. Roses discloses that a document composition web site 110 is connected to a document server 202 that executes the document composition application 206 for creating, editing, viewing, printing and distributing documents (Roses, ¶¶ 0026-28; figs. 1-2).

16. Roses' document composition application 206 is functional to create documents, preview documents, print documents, facilitate purchase of documents, and the like (Roses, ¶ 0032, fig. 3). The document composition

application 206 includes a document creation and selection module 310 that generates documents from templates (*Id.*).

17. Roses' document composition application 206 includes a template database 204 and an image basket application 212 connected to the document creation and selection module (Roses, fig. 3).

18. Roses' document composition web site 110 includes an image basket database 214 connected to both (1) the image basket server 208 that contains the image basket application 212 and also (2) the document server 202 that contains the document composition application 206 (Roses, fig. 2).

19. Roses' image basket application 212 retrieves images to be incorporated into the documents from the image basket database 214 (Roses, ¶ 0032).

20. To incorporate the image into the template, Roses' image basket application 212 is called, and images from other web sites or images stored in the web site 110 that may be used by the user are retrieved (Roses, ¶ 0035).

21. When a user selects an image stored locally at the web site 110, Roses' image basket for the user is updated accordingly (Roses, ¶0065).

ANALYSIS

"Before considering the rejections. . ., we must first [determine the scope of the] claims. . . ." *In re Geerdes*, 491 F.2d 1260, 1262 (CCPA 1974). We therefore first interpret the meaning of the claim language "associated" and the scope of the claim limitation "wherein the base image

associated with the selected image container was not associated with the selected image container by the user."

The word, "associate," is defined variously as: (1) "to connect or bring into relation;" (2) "to join as a companion, partner or ally;" and (3) "to unite; combine" (FF 12). This definition is distinct from the definition of the word, "select:" (1) "to choose in preference to another or others; pick out" (FF 13). As such, a base image may be or connected to—or "associated with"—an image container without necessarily being actually chosen or selected as the specific image that is to be incorporated into an image container. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

Roses discloses a document composition application that allows a user to create a document having selected images incorporated therein (FF 14). More specifically, a document composition web site 110 is connected to a document server 202 that executes the document composition application 206 for creating, editing, viewing, printing and distributing documents (FF 15). The document composition application 206 is functional to create documents, preview documents, print documents, facilitate purchase of documents, and the like (FF 16). The document composition application 206 includes a document creation and selection module 310 that generates documents from templates (FF 16). The document composition application 206 also includes a template database 204 and an image basket application 212 connected to the document creation and selection module (FF 17). The document composition web site 110 further includes an image basket

database 214 connected to both (1) the image basket server 208 that contains the image basket application 212 and also (2) the document server 202 that contains the document composition application 206 (FF 18). The image basket application 212 retrieves images to be incorporated into the documents from the image basket database 214 (FF 19). To incorporate the image into the template, the image basket application 212 is called, and images from other web sites or images stored in the web site 110 that may be used by the user are retrieved (FF 20). When a user selects an image stored locally at the web site 110, the image basket for the user is updated accordingly (FF 21).

To summarize, Roses' images, or "base images," are stored in the system's image basket database. The document templates, or "image containers," are stored in the system's template database 204. As the image basket database and the template database are interconnected to, and accessible by, Roses' document server 202, the base images may be interpreted as being associated with the image containers. Moreover, as this association is effectuated prior to the user selecting a particular one of the "associated" images, one skilled in the art would reasonably interpret Roses as implying that these elements were associated by an entity such as an image provider or web site operator—not the user. *See In re Preda*, 401 F.2d 825, 826 (CCPA 1968) ("[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.").

We find that Roses, itself, discloses the additional limitation of claim 21. Accordingly, we need not address Appellants' argument that the portions of Noda cited by the Examiner fail to teach the limitation. For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's obviousness rejection of representative claim 21. Accordingly, we will sustain the Examiner's rejection of that claim and claim 26 which falls with claim 21.

CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in finding that the cited prior art collectively teaches or suggests providing a user with a visual indication of the portion of a base image that is currently the image content of a selected image container.

Appellants have not shown that the Examiner erred in finding that the cited prior art collectively teaches or suggests someone other than the user associating a base image with the selected image container.

Accordingly, Appellants have not shown that the Examiner erred in rejecting claims 1, 3-7, 11, 13-17 and 21-34 under § 103.

DECISION

We sustain the Examiner's rejections with respect to all pending claims on appeal. Therefore, the Examiner's rejection of claims 1, 3-7, 11, 13-17 and 21-34 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

KIS

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